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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,563	08/02/2000	Keiichi Nakajima	000790/0007	9970
26610	7590	12/14/2006	EXAMINER	
STROOCK & STROOCK & LAVAN LLP			POND, ROBERT M	
180 MAIDEN LANE			ART UNIT	
NEW YORK, NY 10038			PAPER NUMBER	
			3625	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,563

Applicant(s)

NAKAJIMA, KEIICHI

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,36-52 and 63-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 36-52, and 63-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 August 2006 has been entered.

Response to Amendment

All pending claims not withdrawn (2, 4, 36-52, and 63-75) were examined in this non-final office action.

Response to Arguments

Applicant's arguments, see Remarks, filed 30 August 2006 in response to Interview held on 15 August 2006, with respect to the rejection(s) of claim(s) 2, 4, 36-52, and 63-75 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Toohey (US 6,405,176) and Takayama (US 6,332,133). Arguments are moots- previously cited prior art is withdrawn. Toohey teaches a system and method of synchronizing an electronic commerce shopper's purchase with a payment

process as managed by an electronic commerce mall, facilitated by the use of a virtual ledger associated with a virtual store shopping basket, and further teaches managing a plurality of virtual ledgers. Takayama provides pertinent teaches related to wireless commerce and transaction processing.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1. Claim 52 is rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The Applicant appears to be claiming a computer program lacking embodiment and execution by a computer.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims elements are ambiguous based on use of the term "module" as established by the preamble. The Examiner assumes the Applicant is claiming computer software embodied in computer readable medium executable by a computer comprising communication instructions and processing instruction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3. Claims 2, 4, 36-41, 43-48, 50-52, 63-68, 70- 75 are rejected under 35 USC 103(a) as being unpatentable over Toohey (US 6,405,176) in view of Takayama (US 6,332,133).**

Toohey teaches a system and method of synchronizing an electronic commerce shopper's purchase with a payment process as managed by an electronic commerce mall, facilitated by the user of a virtual ledger associated with a virtual store shopping basket, and further teaches managing a plurality of virtual ledgers (see at least abstract ; col. 1-2). Toohey further teaches:

- *a communicating section connected to the communicating network;*

Inherent in Toohey are the structures necessary for a communicating section connected to the communicating network. For example, Toohey

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discloses a electronic commerce shoppers accessing virtual stores managed by a computer-based data processing system (see at least col. 2, lines 1-67). Please note: Toohey references to online shopping sites and making improvements to online shopping sites pertains to online shopping sites connected to a communicating network (see at least col. 1, lines 5-25).

- and a processing unit for communicating with said paying terminal and with said virtual register through said communicating section, said processing unit setting up link information including transaction ID information in association with said virtual register and transmitting said link information which is indicatable in the information indicating unit of the paying terminal upon receipt of the information regarding the transaction transmitted by the paying terminal, said processing unit establishing a synchronization of communication between said paying terminal and said virtual register one-to-one upon receipt of both the same transaction ID information and a signal in response to the link information from said paying terminal. processing unit (i.e. computer-based system that manages electronic commerce transactions in a virtual mall) (see at least Fig. 1 (42); col. 2, lines 52-55); paying terminal (i.e. electronic commerce shopper's electronic device in communication with the virtual mall computer) (see at least Fig. 1 (46); col. 3, lines 30-35); assigning to each electronic commerce shopper a virtual ledger for each virtual store (i.e.

one-to-one relationship) (see at least Fig. 1 (50); col. 2, lines 42-45);
processing unit synchronizes payment into single payment transaction
(see at least col. 2, lines 35-41; col. 3, lines 1-10);

- Cashier server: virtual mall computer performs function of cashier server.
Please see above citations.
- Databases: collects/records/stores all purchase data/transaction data
(please note: what data is stored has no consequence on the system
structure; storing/recording requires memory) (see at least col. 2, lines 42-
51; col. 3, lines 36-46).
- Communication addresses: Inherent in Toohey are the structures
necessary to permit the communication of a network address to the
shopper's terminal. For example, Toohey discloses the shopper accessing
the virtual shopping cart, which in turn communicates with the virtual
ledger, and further disclose that by association of the mall with the virtual
shopping cart, the mall can obtain a reference to each virtual ledger
containing store items (i.e. reference is an identifier) (see at least col. 3,
lines 36-47).

Toohey teaches all the above as noted under the 103(a) rejection and further
teaches the mall server synchronizing a) a payment transaction with the shopper
associated with a virtual ledger, and b) synchronizing a payment transaction
associated with plurality of virtual ledgers, but does not specifically disclose use
of a transaction ID. Takayama teaches an electronic commerce system and

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method and serves as a teaching reference pertaining to the use of transaction identification in the form of transaction numbers uniquely associated with a consumer purchase and payment (see at least Fig. 26 (2616); col.71, lines 32-40). Therefore it would have been obvious to one of ordinary skill in the arts at time of the invention to modify the system and method of Toohey to issue a transaction number unique to a customer purchase and payment as taught by Takayama, in order to associate a given transaction from among a plurality of transactions for a particular purchase.

Toohey teaches all the above as noted under the 103(a) rejection and teaches online communication between an electronic commerce shopper and the electronic mall computer, but leaves one of ordinary skill in the art to ascertain means of online communication with the electronic mall computer. Takayama teaches all the above as noted under the 103(a) rejection and serves as a teaching reference pertaining to the use of wireless devices in electronic commerce shopping. Takayama teaches portable wireless telephones as being more convenient (over wire lines) as a remote device in communication with the digital network, and further teaches portable wireless telephones as a paying terminal with voice input and receiving address information from the online service (please note: digital network uses telephone lines) (see at least Fig. 1 (100, 108); col. 44, lines 7-8). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Toohey to support portable wireless telephones as paying terminals with voice

input capable of receiving network address information as taught by Takayama, in order to provide more convenience to the consumer, and thereby increase sales for the service.

- 4. Claims 42, 49, and 69 are rejected under 35 USC 103(a) as being unpatentable over Toohey (US 6,405,176) and Takayama (US 6,332,133), as applied to claims 36, 43, and 63, and further in view of Official Notice (regarding old and well-known in the arts).**

Toohey and Takayama teach all the above as noted under the 103(a) rejection and teach a) transaction identifiers to uniquely identify a transaction associated with purchase, and b) other information included with the transaction data, but do not disclose information regarding the transaction included a number listed in at least one of a mail order advertisement and a catalog distributed to a user in advance. The Examiner takes the position that it is old and well-known in the arts for merchants to provide a consumer with a catalog reference number (i.e. printed on the catalog) or to identify to a consumer a reference number associated with a particular promotion or advertisement for the purpose of tracking merchant sales activities and/or to offer purchasing incentives associated with the reference number as a consequence of a purchasing transaction. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Toohey and Takayama to include a number listed as taught by Official Notice, in order to

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provide a merchant with tracking information associated with marketing activities and/or purchasing incentives.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert M. Pond
Primary Examiner
December 8, 2006